

### REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested. Claims 1-15 remain pending in the present application.

By way of summary, the Official Action presents the following issues: Figure 2 stands objected to under 37 C.F.R. §1.84(p)(1); Claim 14 stands objected to as having an unclear antecedent basis; Claim 15 stands rejected under 35 U.S.C. §112, second paragraph, as directed toward a product and a process; Claims 1-6, 8-13, and 15 stand rejected under 35 U.S.C. §102(e) as anticipated by Goodman et al. (U.S. Patent No. 6,928,433 B2, hereinafter "Goodman"); and Claims 7 and 14 stand rejected under 35 U.S.C. §103(a) as unpatentable over Goodman in view of Jennery et al. (U.S. Patent Application Publ'n No. 2003/0105847 A1, hereinafter "Jennery").

### STATEMENT OF SUBSTANCE OF INTERVIEW

Applicant and Applicant's representative wish to thank Examiner Wong for the courtesy of the telephonic interview granted on April 23, 2009. During the interview, Examiner Wong explained that the drawings were objected to under 37 C.F.R. §1.84(p)(1). Examiner Wong also attempted to clarify the identify of an alleged clerical informality on page 10 of the Amendment filed February 11, 2009. Because it remains unclear to Applicant's representative what the identity of the alleged clerical informality is, agreement was not reached.

### OBJECTION TO FIGURE 2

As explained during the telephonic interview, the Office objected to Figure 2 under 37 C.F.R. §1.84(p)(1).

As a threshold matter, Applicant notes MPEP § 707.07(g) states that “Piecemeal examination should be avoided as much as possible.” Thus, it is unclear why the objection to original Figure 2 was not raised prior to the outstanding final Official Action.

Further, it is respectfully noted that 37 C.F.R. §1.84(p)(1) states that “Reference characters . . . must not be . . . enclosed within outlines, *e.g.*, encircled.” Applicant respectfully traverses the objection, because the reference characters in original Figure 2 are not encircled.

Applicant respectfully requests the withdrawal of the objection to Figure 2.

#### OBJECTION TO CLAIM 14

The Office objected to dependent Claim 14 as having an unclear antecedent basis. In this regard, Applicant respectfully directs attention to line 5 of Claim 8, as filed on February 11, 2009. Accordingly, it is submitted that Claim 8 provides antecedent basis for “said information processing apparatus,” as recited in dependent Claim 14. Accordingly, Applicant respectfully requests the withdrawal of the objection to Claim 14.

#### REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claim 15 stands rejected under 35 U.S.C. § 112, second paragraph, as directed to a product and a process.<sup>1</sup>

Applicant notes that Claim 15 is directed to “A computer-readable, tangible, storage medium including a computer program, wherein the program . . . causes the computer to execute a procedure . . . .” Applicant further notes that the procedure recited in Claim 15 is not a procedure for using the claimed *storage medium*. Accordingly, it is respectfully submitted that Claim 12 is not indefinite.

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<sup>1</sup> *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384 (Fed. Cir. 2005); MPEP § 2173.05(p)(II).

Further, the Office advances the position that Claim 15 lacks the formality of a tangible storage medium. In this regard, Applicant notes that Claim 15 claims “A computer-readable, tangible, storage medium . . . .” Thus, the nature of the Office’s position is unclear.

Applicant respectfully requests the withdrawal of the rejection of Claim 15 under 35 U.S.C. § 112, second paragraph.

#### REJECTIONS UNDER 35 U.S.C. § 102 AND 103

Claims 1-6, 8-13, and 15 stand rejected under 35 U.S.C. § 102(e) as anticipated by Goodman. Applicant respectfully traverses this rejection.

As a threshold matter, it is noted that the Official Action asserts that one of Applicant’s previously submitted arguments is inapplicable.<sup>2</sup> Applicant notes that it is well-established Office policy that “an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.”<sup>3</sup> It is also well-settled that, “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”<sup>4</sup>

It remains unclear to Applicant what the alleged clerical informality noted by the Official Action is. Assuming *arguendo* the existence of such an informality in the previously presented argument, it contravenes clear Office policy, as described above, to fail to answer the substance of that argument.

Turning to the claims, Claim 1 recites an information processing apparatus, including, in part, a data processor, “said data processor being further configured to compare the acquired recorded data about the transferred contents with the content IDs of said contents stored in said memory . . . .” Applicant respectfully submits that Goodman fails to disclose or suggest those features.

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<sup>2</sup> Official Action at 3, ll. 14-16.

<sup>3</sup> MPEP § 707.07(f).

<sup>4</sup> *Id.*

Goodman concerns a system in which “Once device 300 is coupled to host system 302, a user of host system 302 can launch a bridge interface to allow for the transfer of files between device 300 and host system 302.”<sup>5</sup> Further to Goodman, “The user interface of host system 302 is used to operate the bridge interface to transfer files.”<sup>6</sup>

Thus, Goodman merely describes using a user interface to operate a bridge interface to transfer files. Goodman fails to describe the comparison recited in Applicant’s Claim 1. It is respectfully submitted that Goodman fails to disclose or suggest the feature of “said data processor being further configured to compare the acquired recorded data about the transferred contents with the content IDs of said contents stored in said memory,” as recited in Claim 1.

The Office rejects the above feature by instructing to “see . . . search retrieval queries to populate playlist with Fig. 8 to display as seen on Fig. 14, item 304 . . . .”<sup>7</sup>

In this regard, Applicant notes that “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”<sup>8</sup> Further, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”<sup>9</sup> Applicant submits that the Goodman playlist may be based solely on stored contents, and not on the comparison recited in Claim 1.

Accordingly, it is submitted that Goodman does not inherently disclose or suggest the feature of “said data processor being further configured to compare the acquired recorded data about the transferred contents with the content IDs of said contents stored in said memory,” as recited in Claim 1.

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<sup>5</sup> Goodman, col. 11, ll. 29-31.

<sup>6</sup> Id., ll. 33-35.

<sup>7</sup> Official Action at 4, ll. 2-3.

<sup>8</sup> In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993); MPEP 2112 IV.

<sup>9</sup> Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); MPEP 2112 IV.

Applicant submits that independent Claim 1 (and all associated dependent claims) patentably defines over Goodman.

It is further submitted that independent Claims 8 and 15 (and all associated dependent claims) are allowable for the same reasons as discussed above with regard to Claim 1 and for the more detailed features presented in those claims.

Dependent Claims 7 and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Goodman in view of Jennery. It is submitted that Jennery fails to remedy the above-noted deficiencies of Goodman. Accordingly, Applicant submits that the rejection of dependent Claims 7 and 14 is moot.

Should the above distinctions be found unpersuasive, Applicant respectfully requests that the Office provide an explanation via Advisory Action, pursuant to MPEP § 714.13, specifically rebutting the points raised herein for purposes of facilitating the appeal process.<sup>10</sup>

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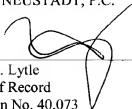
<sup>10</sup> Applicant also notes MPEP § 706.07, which states that "In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and . . . must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal . . . ."

CONCLUSION

Consequently, in light of the foregoing comments, it is respectfully submitted that the present application, including Claims 1-15, as patentably distinguished over the cited art and is in condition for allowance. Such an allowance is respectfully requested at an early date.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Bradley D. Lytle', is written over a horizontal line.

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